

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 15 and 16, and the addition of claim 18, claims 9 to 14, 17, and 18 are pending in the present application. Claims 9 and 17 have been amended to include the features of canceled claim 15. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the acknowledgment that all certified copies of the priority documents have been received.

### **II. Objection to Claim 16**

Claim 16 was objected to under 37 CFR 1.75 as a substantial duplicate of claim 9. While this objection is not necessarily agreed with, to facilitate matters, claim 16 has been canceled herein without prejudice, thereby rendering moot the present objection. Withdrawal of this objection is therefore respectfully requested.

### **III. Objection to Claims 13 and 15**

Claims 13 and 15 were objected to for asserted informalities. Accordingly, claim 13 has been rewritten to correct a minor typographical error, thereby obviating the present objection. Claim 15 has been canceled herein without prejudice, thereby rendering moot the present objection with respect to claim 15. Withdrawal of this objection is therefore respectfully requested.

### **IV. Objection to the Drawings**

The drawings were objected to under 37 CFR 1.83(a) because “the anisotropic disposition of the graphite particles along the habitus plane must be shown or the feature(s) canceled from the claim(s).” (Office Action, p. 2).

It is respectfully submitted that the above-recited feature is shown in the Figure by the graphite particles 14 disposed anisotropically along the habitus plane of the Ag layer 12, i.e. having differing properties along the longest axis of the layer plane, as would be understood by one having ordinary skill in the art. Therefore, withdrawal of the objection to the drawings is respectfully requested.

**V. Rejection of Claims 13 and 15 Under 35 U.S.C. § 112, Second Paragraph**

Claims 13 and 15 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claim 15 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 15, and the features of canceled claim 15 have been included in claims 9 and 17, as presented. It is respectfully submitted that claims 9, 13, and 17 are definite for at least the following reasons.

As more fully set forth above, it is respectfully submitted that one having ordinary skill in the art would understand the feature of claim 13 of the graphite particles 14 being arranged either anisotropically or statistically along a habitus plane of the Ag layer 12.

Claims 9 and 17, as presented, have been rewritten to include the features of canceled claim 15. While the rejection may not be agreed with, to facilitate matters, claims 9 and 17, as presented, have been rewritten to provide the feature that “each of the graphite particles does not simultaneously include a maximum thickness and a maximum width,” thereby obviating the present rejection. It is respectfully submitted that one having ordinary skill in the art would understand that length, width, and thickness refer to each of the three dimensions of each three-dimensional graphite particle, as described in the Substitute Specification, *e.g.* at page 5, lines 1 to 6.

Accordingly, it is respectfully submitted that the present claims sufficiently “set forth and circumscribe a particular subject matter with a reasonable degree of clarity and precision,” which is all that is required under 35 U.S.C. § 112, second paragraph.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claims 9 to 16 Under 35 U.S.C. § 102(b)**

Claims 9 to 16 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,199,553 (“Shinohara et al.”). Claims 15 and 16 have been canceled herein, thereby rendering moot the present rejection with respect to claims 15 and 16. It is respectfully submitted that Shinohara et al. do not anticipate the present claims for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of

Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Claim 9, as presented, relates to a contact surface for an electrical contact, including, *inter alia*, an Ag layer galvanically deposited on a copper-based substrate, the Ag layer including finely dispersed graphite particles, in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*.

Shinohara et al. do not identically disclose, or even suggest, all of the claimed features of claim 9, as presented. Shinohara et al. merely indicate an Ag coating layer that includes graphite particles of various sizes. However, nowhere do Shinohara et al. even mention that each of the graphite particles does not simultaneously include both a maximum thickness and a maximum width. Nowhere do Shinohara et al. refer to such a feature regarding the graphite particle sizes. Thus, Shinohara et al. do not identically disclose, or even suggest, the feature in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*.

Accordingly, Shinohara et al. do not identically disclose, or even suggest, all of the features included in claim 9, as presented. As such, it is respectfully submitted that Shinohara et al. do not anticipate claim 9.

As for claims 10 to 14, which depend from and therefore include all of the features included in claim 9, it is respectfully submitted that Shinohara et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

## **VII. Rejection of Claim 17 Under 35 U.S.C. § 103(a)**

Claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shinohara et al. and U.S. Patent No. 5,967,860 (“Ricketts et al.”). It is respectfully submitted that the combination of Shinohara et al. and Ricketts et al.

does not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 17, as presented, includes features analogous to claim 9, as presented. As more fully set forth above, Shinohara et al. do not disclose, or even suggest, the feature in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*. Ricketts et al. also do not disclose, or even suggest, this feature, and thus, fail to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Shinohara et al. and Ricketts et al. does not disclose, or even suggest, all of the features included in claim 17, as presented. As such, it is respectfully submitted that the combination of Shinohara et al. and Ricketts et al. does not render unpatentable claim 17, as presented.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **VIII. New Claim 18**

New claim 18 has been added herein. It is respectfully submitted that claim 18 adds no new matter and is fully supported by the present application, including the Specification.

It is respectfully submitted that claim 18, which depends from claim 9, as presented, is patentable over the references relied upon for at least the reason that the references relied upon do not disclose, or even suggest, the feature in which *each of the graphite particles does not simultaneously include a maximum thickness and a maximum width*, as recited in claim 9, as presented.

**IX. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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